

REMARKS

Applicants have amended claim 1 and claim 2 to correct minor typographical errors introduced into the claims in applicants' Amendment And Reply To Office Action, dated August 7, 2003 (the "August Amendment").

Applicants have amended claim 28 to indicate that the recited tetrazole group is optionally substituted. Applicants have also amended claim 28 to correct an inadvertent typographical error in the spelling of tetrazole.

None of these amendments adds new matter.

The Advisory Action

The Examiner has not entered applicants' amendments as filed April 5, 2004 for not complying with 37 C.F.R. § 1.121. According to the Examiner, "the listing of the claims does not mention the status of canceled claims 4 and 9-11." Applicants' amendment submitted herewith mentions the status of claims 4 and 9-11 as cancelled thus obviating the Examiner's objections.

Applicants note with appreciation the Examiner's statement that if the amendment were resubmitted in proper format "the amendment would be entered and would overcome" the outstanding § 112, first paragraph rejections, the outstanding objections (see section 3 and 4 of the November 5, 2003 Office Action), and the outstanding § 102(e) rejection of claim 28.

The Examiner indicates however that the § 102(e) rejection of claim 30 (and the claims that depend thereon) would not be overcome by applicants' April 5, 2004 amendment. The Examiner contends that the definition of "heterocyclic group" in applicants' specification includes aromatic rings (see, page 10, line 29 to page 11, line 6). According to the Examiner, the possible unsaturation in a "heterocyclic group", indicates that such groups also include aromatic groups. The Examiner concludes that "there is nothing in Applicants' specification which indicates that the definitions of 'aryl' and 'heterocyclic group' are mutually exclusive." Applicants traverse.

Applicants respectfully suggest that applicants' specification does suggest that the definitions of "aryl" and "heterocyclic" are mutually exclusive. Applicants have given different definitions to the terms "aryl" and "heterocyclic group." The definition of aryl is disclosed as being aromatic; whereas the definition of aryl is disclosed as being saturated or unsaturated. Applicants have also given many examples of each type of ring. Importantly, none of the examples of a "heterocyclic group" are aromatic. Rather, aromatic rings are disclosed as examples "aryl" groups. These definitions are not inconsistent with these terms as would be understood by skilled practitioners. Therefore, given applicants' specification, a skilled practitioner would not understand a tetrazole ring as falling within the definition of "heterocyclic group."

Accordingly, applicants request that the Examiner withdraw this § 102 rejection.

Applicants note with appreciation that the Examiner has amended the inventorship in this application.

Applicants have resubmitted below, their reply submitted April 5, 2004:

The Office Action

The August 2003 Amendment

The Examiner contends that the August Amendment "was not in proper format ... because every claim number was not followed by a parenthetical expression indicating the status of the claim." Applicants have submitted herewith a copy of the claim amendments in the August Amendment with each claim containing a parenthetical expression (see Exhibit A).

Applicants note that their August Amendment may not have properly indicated additions of text. Specifically, applicants intended to amended claim 7 and claim 14 to delete the first word of the claim ("The") and substitute therefor "A." The amendments herein (see above) are presented as if the August Amendment had been entered.

The Declaration

The Examiner contends that the Declaration is defective and has required submission of a new Declaration. Specifically, the Examiner contends that the Declaration omits Golec's city of residence and Brenchly's citizenship. Applicants have submitted herewith an updated Supplemental Declaration And Power Of Attorney For Patent Application reciting the omitted information.

The Inventorship Request

The Examiner contends that the Statements under 37 C.F.R. 1.48(a) for Bebbington, Knegetel, and Mortimore are not in the electronic file wrapper. The Examiner notes that these documents may have been "submitted, but not scanned into the electronic file wrapper." Accordingly the Examiner has requested applicants to "resubmit copies of the statements." Applicants have submitted herewith the copies as requested by the Examiner.

For all of the above reasons, applicants request that the Examiner withdraw the above objections.

The Rejections35 U.S.C. § 112, Second Paragraph

Claims 8, 12-17, 29, 30, and 34-42 stand rejected under 35 U.S.C. § 112, second paragraph "as failing to comply with the written description requirement." The Examiner contends that "[t]he claim(s) contains subject matter which was not described

in the specification in such a way as to reasonable convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Specifically, the Examiner contends that "[t]here is no original disclosure supporting the recitation in claims 29 and 30 in the definition of R' that each group can be optionally substituted." Applicants traverse.

Applicants respectfully submit that the definition of R' in claims 29 and 30 is supported by the original description. The description discloses that each of the groups in R' may be optionally substituted. Specifically, the description at page 11 lines 13-22 discloses that each aliphatic, aryl, and heterocyclic group may be optionally substituted. The definition of aliphatic includes cycloalkyl groups (page 10, lines 3-4). Therefore, each of the groups recited in the definition of R' is disclosed in applicants' description as being optionally substituted.

Claims 8, 12-17, and 28 stand objected to on the basis of an informality, namely the misspelling of "tetrazolyl" in claim 28. Applicants have amended claim 28 to correct this inadvertent typographical error thus obviating these objections.

35 U.S.C. § 102 and § 103

Claims 8, 12, 16, 17, 28, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ohmoto et al., U.S.

6,136,834 ("Ohmoto et al."). Claims 13-15 stand rejected under 35 U.S.C. § 103 as being obvious over Ohmoto et al. The Examiner contends that Ohmoto et al. examples 18(23), 18(24), 19(21), and 19(22) fall within the scope of applicants' claims. The Examiner has considered the arguments in applicants' August Amendment but found them unpersuasive for reasons related to claim 28 and claim 30 rejections. Applicants traverse each of these rejections below.

The Examiner contends that claim 28 encompasses Ohmoto et al. compounds. Specifically, the Examiner contends that claim 28 excludes only unsubstituted tetrazoles and that Ohmoto et al. includes optionally substituted tetrazoles. The Examiner has indicated that amending claim 28 to exclude substituted tetrazoles would overcome the claim 28 rejection. Applicants amended claim 28 as suggested by the Examiner thus obviating this rejection.

The Examiner also contends that claim 30 encompasses compounds of Ohmoto et al. if applicants' R' group is R, and if R is a substituted heterocycloalkyl group. Applicants respectfully submit that applicants' definition of heterocycle does not include "tetrazole" (see description as originally filed at page 10, line 12 to page 11, line 6). As defined in applicants' description, a tetrazole group would fall within the definition of "aryl" not the definition of "heterocycle" (compare definition

of "aryl" at page 10, lines 12-28 and definition of "heterocyclic group" at page 10, line 29 to page 11, line 6). Conveniently, applicants' description lists tetrazole as exemplifying an aryl group (page 10, line 27). Claim 30, therefore, does not encompass compounds of Ohmoto et al. if R' is R, and if R is a substituted heterocycloalkyl group.

For all of the above reasons, applicants request that the Examiner withdraw these § 102 and § 103 rejections.

The Allowable Subject Matter

Applicants acknowledge with appreciation that 1) claims 1-3, 5-7, 18-27, and 31-33 stand allowed; and 2) claims 29 and 34-42 "would be allowable if rewritten to overcome the rejections(s) under 35 U.S.C. 112, first paragraph. Applicants respectfully submit that they have overcome the 112, first paragraph rejections (see above). Accordingly, applicants request that the Examiner consider claims 29 and 34-42 allowable also.

Conclusion

In view of the above, applicants request that the Examiner enter the above amendments, consider the foregoing

remarks, and allow the pending claims to issue.

Respectfully submitted,



Lisa A. Dixon (Reg. No. 40,995)
Attorney for Applicants

VERTEX PHARMACEUTICALS INCORPORATED
130 Waverly Street
Cambridge, Massachusetts 02139
Telephone: (617) 444-6396
Facsimile: (617) 444-6483